

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

20412-8383

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Application Number

10/814,932

Filed

March 30, 2004

First Named Inventor

Peter E. Hart

Art Unit

2625

Examiner

J. Thompson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Jennifer R. Bush/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

Jennifer R. Bush

Typed or printed name

☒ attorney or agent of record.
Registration number 50,784

650-335-7213

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

April 15, 2009

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
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☐ *Total of _____ forms are submitted.

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**REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW IN U.S. PATENT
APPLICATION NO. 10/814,932 FILED ON 3/30/2004**

Pre-appeal brief review is appropriate in this application because the rejections in the Final Office Action dated January 15, 2009 (“FOA”) contain clear deficiencies. The rejections of claims 1, 4-27, 29, 31-41, 43-49, and 56-68 should be withdrawn. As set forth below, the cited references fail to disclose the claimed limitations and thus *prima facie* obviousness as required by MPEP 2143.03 has not been established.

Claims 1, 16, 21, 24, 25, 41, 47, and 56-65 are pending and stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over US 5,633,723 B1 to Sugiyama (“Sugiyama”) in view of US 5,987,226 to Ishikawa (“Ishikawa”) and US 6,556,241 B1 to Yoshimura (“Yoshimura”). This rejection now is traversed.

Claim 1 recites a printer comprising, *inter alia*, “a multimedia processing system within the printer ... that issues a command that controls the media source to transmit ... time-based media to the multimedia processing system”

Sugiyama, Ishikawa, and Yoshimura, considered either alone or in the suggested combinations, do not disclose or suggest at least this claimed feature. The Examiner admits that Sugiyama and Ishikawa do not disclose this claimed feature. *See* FOA, p. 5, ll. 20-22. Yoshimura does not remedy the deficiencies of Sugiyama and Ishikawa for several reasons.

None of the elements of Yoshimura **issue a command that controls a media source**. Yoshimura describes a system that enables a plurality of users to control a plurality of cameras remotely. *See* Yoshimura, FIG. 1 and Abstract. Yoshimura describes clients, a camera server, and camera controllers that merely *translate* and *route* various signals based on *user-generated*

inputs from a client to a camera apparatus. *See* Yoshimura, FIGS. 1-4 and col. 5, ll. 49-50. At best, as stated by the Examiner, Yoshimura suggests “how to *handle* commands” between devices. *See* FOA, p. 3, ll. 5-6. The Examiner further states that Yoshimura is relied upon only to show “how commands are *transmitted* and *carried out*.” *See* FOA, p. 2, ll. 19-21. Neither handling a command, transmitting a command, or carrying out a command comprise **issuing** a command. The claimed invention clearly recites a multimedia processing system that **issues** a command.

Even assuming *arguendo* that relaying or translating (i.e., handling) user inputs as described by Yoshimura could be interpreted as **issuing** a command that controls a media source, Yoshimura would still fail to show a **multimedia processing system** that issues the command as claimed. At best, Yoshimura describes a video capture unit that converts a video signal to picture data. *See* Yoshimura, col. 7, lines 15-17. However, conversion of video signals to picture data is the only functionality Yoshimura ascribes to the video capture unit. Yoshimura does not even describe the video capture unit as transmitting a command, much less **issuing** a command. Like the other elements of Yoshimura’s system, the video capture unit therefore fails to teach the claimed multimedia processing system at least because it does not **issue a command that controls a media source to transmit time-based media to the multimedia processing system** as claimed.

The elements of Yoshimura, including the video capture unit, are also unlike the claimed multimedia processing system because they are not “within a printer.” Indeed, neither “printer” nor “printing” appear anywhere within Yoshimura. The Examiner has gone so far as to explicitly state that “Yoshimura has not been relied upon for anything with respect to printing.” *See* FOA, p. 2, ll. 19-21. Applicants respectfully submit that, given that Yoshimura has nothing

to do with printing, no element of Yoshimura can reasonably be interpreted as teaching a “a multimedia processing system **within the printer** ... that issues a command that controls the media source to transmit ... time-based media to the multimedia processing system” as claimed.

As a result of Yoshimura being entirely unrelated to printing, the Examiner is forced to rely on a combination of Yoshimura and the printer of Sugiyama and the printing system of Ishikawa. However, due at least to the above-described deficiencies, such a combination would not yield the claimed invention. At best, a combination of Sugiyama, Ishikawa, and Yoshimura would yield a video printer that accepts and translates *user input* to allow *a user to control* a camera apparatus. The combination would not include “**a multimedia processing system within [a] printer ... that issues a command that controls [a] media source to transmit [] time-based media to the multimedia processing system.**”

Not only would a combination of Sugiyama, Ishikawa, and Yoshimura fail to yield the claimed invention, but the Examiner’s assertion that the combination would be obvious is misplaced. The Examiner has stated that “*if* one of ordinary skill in the art were presented with Yoshimura, one of ordinary skill in the art would then have... details of how a client device...can *communicate* with [a] time-based media source.” *See* FOA, p. 3, ll. 9-12. However, Applicants respectfully submit that the Examiner’s analysis improperly assumes that one of ordinary skill in the printing arts would look to Yoshimura in the first place. As described above and admitted by the Examiner, Yoshimura describes relaying commands to a camera apparatus in a context far removed from any printer. Hence, Applicants submit that, even assuming *arguendo* that the combination of Yoshimura with Sugiyama and Ishikawa would show the claimed elements, one of skill in the art would not be motivated to modify Sugiyama and Ishikawa to include various aspects of Yoshimura as suggested by the Examiner, and would

not look to the art of Yoshimura for guidance. Applicants also respectfully submit that the Examiner's analysis improperly equates simply *communicating* with a time-based media source with **issuing** a command that controls a media source. Thus, the Examiner's proposed combination appears to be based on improper hindsight reasoning, with guidance gleaned solely from Applicants' own disclosure. *See* MPEP 2145 (Examiner's rationale may "not include knowledge gleaned only from applicant's disclosure").

Applicants also note that the standard is not whether the references *can* be combined, but what the combined teachings would have suggested to those of ordinary skill in the art. Specifically, to combine Yoshimura with the other references, Yoshimura's camera server, camera controller, client, and user would need to be integrated into the printer for the reasons discussed above. Also, as previously described, the Examiner has admitted that Yoshimura has nothing to do with printing. *See* FOA, p. 2, ll. 19-21. Hence, at a minimum, combining Yoshimura with the other references would take the elements of Yoshimura far afield of their "established functions," precluding the "predictability" of such combining and making it unlikely that the claimed invention would be obvious to those of skill in the art. Thus, the claimed invention is "more than a predictable use of [these] prior art elements according to their established functions." *See KSR*, 127 S.Ct. 1727, 1739 (2007).

For at least the above-stated reasons, claim 1 is patentable over Sugiyama, Ishikawa, and Yoshimura, alone or in the suggested combinations. Dependent claims 16, 21, 24, 25, 56-59, 62, and 63 each incorporate all the limitations of claim 1 and are patentable over the cited references for at least the same reasons, and include additional patentably distinguishable limitations.

Independent claim 41 recites a method for printing time-based media and includes limitations similar to those discussed above with respect to claim 1. Therefore claim 41 and its

dependent claims 47, 60, 61, 64, and 65 are patentable over the cited references for at least the same reasons provided above in reference to independent claim 1.

Claims 4-15, 17-20, 22, 23, 26, 27, 29, 31-40, 43-46, 48, 49, and 66-68 are pending and stand rejected under U.S.C. 103(a) as allegedly being unpatentable over Sugiyama, Ishikawa, and Yoshimura in various combinations with USPN 6,193,658 B1 to Wendelken; USPA Pub. No. 2003/0220988 A1 to Hymel; USPA Pub. No. 2002/0185533 A1 to Shieh; USPN 6,118,888 to Chino; USPA Pub. No. 2002/0010641 A1 to Stevens; USPN 5,436,792 to Leman; USPA Pub. No. 2002/0048224 A1 to Dygert; USPN 5,568,406 to Gerber; USPN 4,881,135 to Heilweil; USPN 4,807,186 to Ohnishi; USPN 6,115,718 to Huberman; USPA Pub. No. 2002/0169849 to Schroath; USPN 4,754,485 to Klatt; USPN 5,432,532 to Mochimaru; USPA Pub. No. 2002/0137544 to Myojo; and USPN 6,020,916 to Gerszberg ("Gerszberg"). These additional cited references do not disclose or suggest the limitations absent from Sugiyama, Ishikawa, and Yoshimura discussed above, nor does the Examiner assert that they do. Therefore, claims 74-15, 17-20, 22, 23, 26, 27, 29, 31-40, 43-46, 48, 49, and 66-68 also are patentable over all of the references cited above, taken alone or in the suggested combinations.

Therefore, it is requested that the final rejections of claims 1, 4-27, 29, 31-41, 43-49, and 56-68 be withdrawn.

Respectfully submitted,
Peter E. Hart et al.

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By: /Jennifer R. Bush/
Jennifer R. Bush, Reg. No.: 50,784
Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Tel.: (650) 335-7213
Fax.: (650) 938-5200